



Atty. Dkt. No. 086142-0493

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masahiro SHIOTANI et al.
Title: SEAT BELT RETRACTOR
Appl. No.: 09/985,924
Filing Date: 11/6/2001
Examiner: William A. Rivera
Art Unit: 3654

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the **New Pre-Appeal Brief Conference Pilot Program**,
announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice
of Appeal.

REMARKS

The rejection of claims 1, 3, 5-9 and 11-15 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,899,399 ("Brown") in view of U.S. Patent No. 2,586,099 ("Schultz") and U.S. Patent No. 5,794,877 ("Ono") is presented for review.

Allowable Subject Matter

It is noted with appreciation that claims 2 and 10 contain allowable subject matter.

Rejections

Claims 1, 3, 5-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,899,399 ("Brown") in view of U.S. Patent No. 2,586,099 ("Schultz") and U.S. Patent No. 5,794,877 ("Ono"). The rejection should be withdrawn because a *prima facie* case of obviousness has not been made. There is no motivation for combining the references.

According to the Office Action, it would have been obvious to provide Brown with a steel bearing of Schultz for "the purpose of protecting the surface of the spool." Office Action at p. 2. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2142. The Examiner's motivation is not found in the prior art. The bearing 102 identified in Brown supports a retractor shaft 108 for rotation in a belt winding direction W and in an opposite belt unwinding direction. *See* Brown at col. 3, lines 28-32; and Fig. 5. The bearing 102 of Brown merely appears to be used for providing a smooth webbing retraction and extraction. In contrast, only the present application identifies a problem with conventional retractors and suggests the desirability of a bearing comprising a material with a greater hardness than the spool, such as steel, as called for in claims 1, 3, 9 and 11. *See* Application at ¶¶ 6 and 24. A bearing 30 in the present application is used to prevent "the shaft portion 2A of the spool from being deformed." Published Application at ¶ 58. Thus, the rejection is clearly based on impermissible hindsight reasoning and there is no basis for

the combination relied upon by the Examiner. Therefore, the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 5-8 depend from claim 3 and claims 11-15 depend from claim 11 and are allowable therewith, for at least the reasons set forth above, without regard to the further patentable subject matter set forth in these dependent claims.

Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

October 14, 2005

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